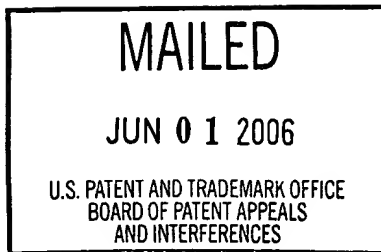The opinion in support of the decision being entered today
was **not** written for publication and is **not** binding precedent of
the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte RICHARD W. CHESTON and DARYL C. CROMER

_____

Appeal No. 2006-1130
Application No. 09/248,160

_____

ON BRIEF

_____

Before CRAWFORD, LEVY and NAPPI, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of

claims 1 through 21. For the reasons stated *infra* we reverse the examiner's

rejection of these claims.

Invention

The invention relates to a system for loading programs onto a personal computer. Claim 7 is representative of the invention and reproduced below:

> 7.   A method of installing a variable selection of software programs on a personal computer, the steps of the method comprising:
>
> loading onto the personal computer storage a plurality of software programs in unusable form, including some software programs needed for that computer and other software programs which are not needed for that computer;
>
> selecting the software programs which are needed for that personal computer;
>
> converting from unusable form into usable form the software programs which have been selected;
>
> storing the converted software programs in usable form into the storage of the personal computer; and
>
> paying royalties only on the programs which have been selected, converted and stored in the storage in usable form.

References

The references relied upon by the examiner are:

Carroll	6,530,019	Mar. 4, 2003 (filed June 12, 1996)
Casey et al. (Casey)	6,243,745	Jun. 5, 2001 (filed July 17, 1998)
Wiedemer	5,155,680	Oct. 13, 1992
Stringer et al. (Stringer)	E.P.O. Patent Application 0,601,500 A1	Jun. 15, 1994

Rejection at Issue

Claims 12, 13 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stringer in view of Carroll. Claims 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stringer in view of Carroll and Wiedemer. Claims 1, 2, 4 through 6 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stringer in view of Carroll and Casey. Claims 3, 9 through 11, 16 through 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stringer in view of Carroll, Casey and Wiedemer. Throughout the opinion we make reference to the briefs and the answer for the respective details thereof.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellants and the examiner, and for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 21 under 35 U.S.C. § 103.

Rejection of claims 12, 13 and 15.

Appellants argue on page 6 of the brief:

Stringer teaches the so called "try and buy" technique whereby actual operational software is loaded into a computer or transferred to the user of the computer and wherein that software is operational in either a full function of limited function mode so that the user may evaluate the software and thereafter purchase the software.

Appellants, thus assert, on page 6, that Stringer does not teach or suggest "loading of a computer system with unusable software wherein selected portions of the software are thereafter converted to a usable form" as is claimed in independent claim 12. Appellants argue that Carroll teaches a system where programs are loaded into the computer in unusable form, and then when certain actions are performed all of software is made usable. Thus, appellants assert that Carroll also fails to teach or suggest a system whereby unusable programs are selected and made active while others are not. Further, appellants argue on page 7 of the brief:

Stringer expressly teaches that all forms of software loaded within the system are active and fully usable for evaluation purposes the combination of *Carroll* and *Stringer* is improper as software could not possibly be evaluated as taught by *Stringer* if it is initially loaded into a hard drive which is not accessible, as taught by *Carroll*. Consequently, any attempt at a combination of *Carroll* and *Stringer* does clear violence to the teaching of each reference.

In response the examiner, states on pages 11 and 12 of the answer:

[T]he Carroll reference was added to more clearly demonstrate that software can be made unusable before being selected for use. That is, Stringer already discloses that different versions or a variety of computer software are preinstalled on a computer and that the software of interest is selected for purchase (col 5, lines 35-45; col. 13, lines 30-50). The

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Carroll reference was added to demonstrate that the software can be made unusable before being selected for use. Also, as noted in the Response to Arguments above, Stringer already discloses that 'one or more parts' of the software can be disabled and also that the software can be provided in a disabled form until the software is selected and then enabled or authorized.

Further, in response to appellants arguments directed to the combinability of Carroll and Stringer, the examiner states that Stringer discloses much flexibility in implementing the invention.

We disagree with the examiner's rationale and do not find that one would be motivated to combine the references as asserted by the examiner. The examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker,* 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). It is the burden of the examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by the implication contained in such teachings or suggestions. *In re Sernaker,* 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." *In re Huston,* 308 F.3d 1267, 1280, 64 USPQ2d 1801, 1810 (Fed. Cir. 2002, citing *In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ 1313, 1317 (Fed. Cir. 2000)). Independent claim 12 recites limitations directed to programs being loaded on a computer system in such a way that they are unusable, and that there is a

module to select certain programs make them usable. We do not find that either Stringer or Carroll teaches or suggests such a system; further, we do not find that the nature of the problems to be solved in Stringer or Carroll would suggest combining the references to make obvious such a system.

Stringer teaches a system to allow a user to evaluate a trial version of a software program. See column 5, lines 36 through 40. The entire program is preloaded onto the computer and a trial or evaluation version is created by disabling parts of the program. See column 6, lines 46 through 54, column 13, lines 24 through 28. Stringer's system provides a menu on initial start up which allows the user to select programs to buy, the user is then, through a call center given an enable code to access the full program. See column 15, lines 1 through 10. We do not find that the programs are un-usable prior to purchase and entry of the access code. Rather the programs are in the evaluation version and have limited use. Nor do we find any suggestion that the software should be un-usable until the software is selected.

Carroll teaches a system to disable all the software on a disk until the user agrees to a software contract. See abstract. Carroll identifies that when software is purchased separate from a computer it contains a "shrink-wrap contract," the packaging identifies that by the user opening the package the user accepts the terms of the software contract and copyright agreements. However, when the software is preloaded onto a computer there is no equivalent activity to acknowledge acceptance of the software contract. See column 1, lines 29

through 50. Accordingly, Carroll's system solves this problem by creating a system where all software on the computer is disabled until the user of the computer acknowledges reading and accepting the terms of the software contract. See column 1, lines 56 through 59. Carroll thus, teaches that all of the software should be disabled (unusable) or enabled (usable), we do not find any teaching of suggestion in Carroll that select software should be enabled and other software should not be enabled.

Thus, we do not find any suggestion in either Stringer or Carroll to modify the references as asserted by the examiner. Further, as appellants argue, we consider the concept of disabling all of the functionality of the software, such as taught by Carroll, to be at odds with the purpose of providing users with an evaluation copy of the software. Thus, we do not find that the examiner has established a prima facie case of obviousness and will not sustain the examiner's rejection of claims 12, 13 and 15 under 35 U.S.C. § 103 as being unpatentable over Stringer in view of Carroll.

Rejection of claims 7 and 8.

The examiner rejects claims 7 and 8 under 35 U.S.C. § 103 as being unpatentable over Stringer in view of Carroll and Wiedemer Independent claim 7 recites limitations directed to loading into a computer a plurality of programs in unusable form, selecting programs, converting the selected programs to usable form and storing the programs on the personal computer. Similar to the rejection

of claim 12, the examiner's rejection relies upon the combination of Stringer and

Carroll to teach these limitations. The examiner does not assert, nor do we find

that Wiedemer teaches these limitations. Thus, for the reasons stated *supra*

with respect to claim 12, we will not sustain the examiner's rejection of claims 7

and 8.

Rejection of claims 1, 2, 4 through 6 and 14.

The examiner rejects claims 1, 2, 4 through 6 and 14 under 35 U.S.C. §

103 as being unpatentable over Stringer in view of Carroll and Casey.

Independent claim 1 recites limitations directed to a computer being initially

loaded with software in unusable form, where selected programs are converted

to useable form and stored on the computer, non-selected programs are not

converted to usable form. Similar to the rejection of claim 12, the examiner's

rejection relies upon the combination of Stringer and Carroll to teach these

limitations. The examiner does not assert, nor do we find that Casey teaches

these limitations. Thus, for the reasons stated *supra* with respect to claim 12, we

will not sustain the examiner's rejection of claims 1, 2, 4 through 6 and 14.

Rejection of claims 3, 9 through 11, 16 through 21.

The examiner rejects claims 3, 9 through 11, 16 through 21 under 35

U.S.C. § 103 as being unpatentable over Stringer in view of Carroll, Casey and

Wiedemer. Independent claim 16 recites limitations directed to loading a set of

programs on a computer in unusable form, selecting a subset of the programs,
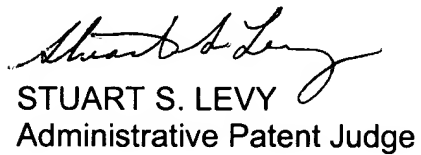
converting the subset of programs to usable form and storing them on the computer. Similar to the rejection of claim 12, the examiner's rejection relies upon the combination of Stringer and Carroll to teach these limitations. The examiner does not assert, nor do we find that either Casey or Wiedemer teaches these limitations. Thus, for the reasons stated *supra* with respect to claim 12 we will not sustain the examiner's rejection of claims 3, 9 through 11, 16 through 21.

In summary, we will not sustain the examiner's rejection of claims 1

through 21 under 35 U.S.C.§ 103. The decision of the examiner is reversed.

REVERSED

MURRIEL E. CRAWFORD   )
Administrative Patent Judge   )
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)
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) BOARD OF PATENT
STUART S. LEVY   ) APPEALS AND
Administrative Patent Judge   ) INTERFERENCES
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ROBERT E. NAPPI   )
Administrative Patent Judge   )

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Appeal No. 2006-1130
Application No. 09/248,160

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